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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,862	03/23/2005	Shiv Kumar	PB0371	1501

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GE HEALTHCARE BIO-SCIENCES CORP.  
PATENT DEPARTMENT  
800 CENTENNIAL AVENUE  
PISCATAWAY, NJ 08855

EXAMINER
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SOLOLA, TAOFIQ A

ART UNIT	PAPER NUMBER
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1625.

MAIL DATE	DELIVERY MODE
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04/30/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/528,862

Applicant(s)

KUMAR ET AL.

Examiner

Taofiq A. Solola

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-12,28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 13-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1</u> .   | 6) <input type="checkbox"/> Other: ____                           |

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Claims 1-29 are pending in this application.

## DETAILED ACTION

### *Election/Restriction*

Claims 1-29 are drawn to more than one inventive concept (as defined by PCT Rule 13) and, accordingly, a restriction is required according to the provision of PCT Rule 13.2.

PCT Rule 13.1 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (requirement of unity of invention).

PCT Rule 13.2 states that unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

Annex B, Part 1(b), provides that "special technical features" mean those technical features which, as a whole, define a contribution over the prior art (novelty/unobviousness).

I. Claims 1-12, drawn to compounds of formula I, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

II. Claims 13-27, drawn to compounds of formula II, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

III. Claims 28-29, drawn to method of using compounds of formula I or II, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

In the instant inventions, the only structural element shared by groups I-III is fluorescein dyes. However, fluorescein dyes are known in the art. Burdette et al. J. Ame. Chem. Soc. (2001) Vol 123, Pages 78341-7841. Therefore, under PCT Rules 13.1 and 13.2, fluorescein dyes do not constitute a corresponding special technical feature among the groups.

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In a telephone call made to Younggang Jig on 4/18/07, to request an oral election a provisional election was made to prosecute the invention of group II. The election was made without indication as to if it was with traverse therefore, it is deemed made without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Rejoinder***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder

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in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the examiner before the patent issues withdraws the restriction requirement. See MPEP § 804.01.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Letter "F" is used two different ways in the specification. It is used as halogen and also as a substituent in formula II. The substituent must be changed to a different letter or F' (F-prime).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 13-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Letter "F" is used two different ways in claim 13. It is used as halogen and also as a substituent in formula II. This renders claims 13-27 confusing and therefore, indefinite. The substituent must be changed to a different letter or F' (F-prime).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al., US 5,863,727, in view of, Burdette et al., J. Ame. Chem. Soc. (2001) Vol 123, Pages 78341-7841.

Applicant claims fluorescein dyes of formula II having linkers to acceptor dyes. The acceptor dyes are xanthine, rhodamine and cyanine dyes.

#### **Determination of the scope and content of the prior art (MPEP §2141.01)**

Lee et al., teach fluorescence dyes having a generic formula, which embraces the instantly claimed dyes. The dyes can be linked to xanthine, rhodamine and cyanine dyes. See col. 4, lines 20-38, col. 7, line 27, col. 8, lines 17-65 and the examples.

#### **Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)**

The difference between the instant invention and that of Lee et al., is that applicant claims dyes that are sub-generic of the generic formula by Lee et al.

#### **Finding of prima facie obviousness--rational and motivation (MPEP §2142.2413)**

However, Burdette et al., teach fluorescence dyes that are similar to the instantly claimed dyes useful as sensors for zinc. Therefore, the instant invention is prima facie obvious

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from the teachings of Lee et al., and Burdette et al. One of ordinary skill in the art would have known to claim dyes wherein R11 and R14 are amine at the same time Y1 is OH and Y2 is oxygen, from the generic teaching of Lee et al. The motivation is from the teaching of Burdette et al., that compounds having these sub-combinations have fluorescence property.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas McKenzie, can be reached on (571) 272-0670. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding, should be directed to the Group receptionist whose telephone number is (571) 272-1600.

  
**TAOFIQ SOLOLA  
PRIMARY EXAMINER**

Group 1625

April 24, 2007